

R E M A R K S

Claims 1-10 are pending. Support for new claim 10 can be found in Example 1 of the specification as filed beginning on page 39 at about line 7. The compound of new claim 10 has the structure of formula (8). The compound of new claim 10 is a species of claim 1 and is the methacrylate of formula (1) wherein R<sup>1</sup> and R<sup>2</sup> are both methyl. Claim 10 belongs to Group I as the Examiner has grouped the claims in the last Office Action.

Provisional Election

A provisional election, with traverse, is made of the claims of Group I namely claims 1 and 10.

Traversal of Restriction

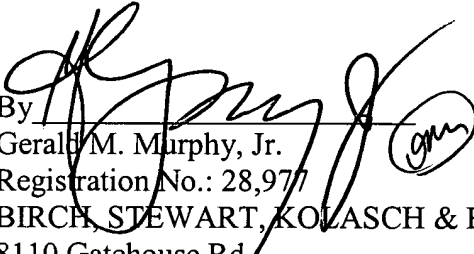
The restriction requirement in the last Office Action is traversed for the reasons stated in the attachment, the entire contents of which are incorporated herein by reference.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy, Registration No 22,751 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: **SEP 30 2005**

Respectfully submitted,

  
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## **MEMORANDUM OF LAW RESTRICTION**

An Office Action in the nature of a restriction requirement has been issued in the pending patent application to which this memorandum is attached. This memorandum is incorporated into the response to that Office Action as fully as if set forth therein in its entirety.

### Traversal of Restriction Requirement

The restriction requirement is traversed on multiple grounds. Depending on the facts of the case at bar these grounds include: the statutory standard has not been met; the classification system does not support a restriction requirement; applicant has a right to define his invention; there is no serious search burden; applicant has paid for an examination of all claims; the Patent Cooperation Treaty (PCT) prohibits this restriction; and in any case, discretion should be exercised and restriction not required.

### The Statutory Restriction Standard Has Not been Met

The Patent statute states:

"If two or more independent and distinct inventions are claimed in one application, the Commissioner MAY require the application to be restricted to one of the inventions." (Emphasis supplied, 35 USC 121)

The standard requires that the allegedly multiple inventions be "independent and distinct". This standard has not been met. In support of the restriction the Examiner may have argued that the product can be made by a process other process than that claimed. Assuming, for the sake of argument, that this is true, it follows that the product can be made by the claimed process. This means that the product and process are not independent and distinct. The statutory standard has not been met.

## Classification Does Not Support a Restriction Requirement

The patent statute states:

“The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.” 35 USC 9

The classification system exists “... for the purpose of determining...novelty ...” not to determine whether a claim defines multiple inventions, and certainly not for determining whether any multiple inventions may or may not be independent and distinct.

The public has no right to be heard on the classification system. This means the Commissioner is completely free to define classes and subclasses as he see fit. Such independent authority is necessary to make the subclasses sufficiently small for easy searching, not to determine the presence or absence in a single case of multiple inventions. Subclasses frequently undergo division into multiple subclasses. Such division is for efficient novelty searching not to provide an argument that multiple search classes are equal to multiple inventions.

Congress never intended to empower the Commissioner to develop a search classification system and then use that search system to determine the possible presence in a single case of multiple inventions.

Any Examiner's argument that the pending claims are directed to more than one invention, because they are in different search subclasses is simply not relevant.

## Applicant Has a Right to Define His Invention

By requiring the restriction, applicants are deprived of their statutory rights under 35 USC 112 to have "claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention." The Examiner has, in effect, carved out a portion of applicant's invention and rejected it under the guise of a restriction requirement under 35 USC 121. This the Examiner may not do.

### The Search Here Does Not Impose a Serious Burden

The Manual of Patent Examining Procedure ("MPEP") states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (MPEP Sec. 803)

There is no serious burden here. Assuming, for the sake of argument, that the Examiner has correctly enumerated and characterized the subclasses that need be searched, the total number of subclasses is small. The number of patents in each subclass is, or should be small. The Examiner has made no showing that a search of this number of subclasses is a "serious burden". The burden of proof to show "serious burden" is on the Examiner. This burden has not been met.

### Applicant Has Paid for Examination of All Claims

Having paid an application fee, the applicant is entitled to have the Examiner determine the novelty and non-obviousness of the subject matter claimed. If this requires a search of multiple subclasses, so be it.

### The PCT May Prohibit This Restriction

If the pending application were filed under the Patent Cooperation Treaty (PCT), restriction is improper.

A requirement for restriction such as the one made here is contrary to the PCT and its rules which state:

"[PCT] Rule 13.1 shall be construed as permitting, in particular, one of the following three possibilities:

(i) In addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the said product..." (PCT Rule 13.2; 37 CFR 1.475 (f))

Even if this case were not filed under the provisions of the PCT, it is nevertheless entitled to the benefit of its provisions because: (a) the PCT and the applicable rules are the law of the land as enacted by congress and (b) the applicant is entitled to the equal protection clause of the Constitution of the United States and (c) only one criterion exists and that criterion is unity of invention under the PCT Rule above cited; and (d) the above PCT rule has been incorporated into the rules of practice namely 37 CFR 1.487(b).

Birch, Stewart Kolasch and Birch  
Attorneys at law  
Last revised: July 11, 2005

A handwritten signature, possibly "BKS", enclosed within a hand-drawn circle.